

Att'y Dkt. No.: LIFI033
DSSN: 10/052,212

REMARKS

Formal Matters

Claims 97-144 are pending in the application. Claims 97-144 have been examined. Claims 126-132 and 137 have been withdrawn from consideration and claims 97-125, 133-136 and 138 and 144 have been rejected.

Claims 113 and 133 have been amended to specify that the cover and base provide a substantially air and moisture tight seal at the interface of the cover and base when the two are in a mated configuration. Support for this amendment may be found throughout the specification, e.g., paragraphs [0055] and [0058] – [0068]. Claim 115 has been amended to change the dependency thereof and claims 138 has been amended to remove reference to withdrawn claim 126.

Claim 114 has been canceled.

No new matter is added. Accordingly, the Applicants respectfully request entry of the amendments.

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 97-125, 133-136 and 138-144, the only claims pending in this application.

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RESTRICTION

The Applicants affirm the election to prosecute claims 97-125, 133-136 and 138-144. While the Office Action states that claims 126-127 and 132 are withdrawn from consideration as being drawn to a non-elected invention, the Applicants note that claims 126-132 and 137, corresponding to inventions II and III, are drawn to a non-elected invention. Accordingly, claims 126-132 and 137 have been withdrawn.

REJECTION UNDER 35 U.S.C. §102(e)

Claims 113-125, 133-136 and 138-144 have been rejected under 35 USC §102(e) as being anticipated by Bottswein, et al. (US 6,534,017 131). As described above, independent claims 113 and 133, and the claims that depend therefrom, have been amended to specify a device that includes a base and a cover that provide a substantially air and moisture tight seal at the interface of the base and cover when the base and the cover are in a mated configuration. However, the test element storage device of Bottswein et al. does not include a base and a cover that, when in a mated orientation, provide a substantially air and moisture tight seal at the interface of the mated base and cover.

Accordingly, for at least this reason, the cited reference does not anticipate the subject claims. As such, the Applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. §103(a)

Claims 97-112 have been rejected under 35 USC §103(a) as being unpatentable over Bottswein et al. Independent Claim 97, and the claims that depend therefrom, specify that the height of the base is less than the length of each of the test strips, such that a portion of each of the test strips stored in the base extends beyond the height of the base. However, Bottswein et al. fail to disclose, teach or fairly suggest a magazine that includes a base having a height dimension that is less than the length of each of the test strips such that a portion of each of the test strips stored in the base extends beyond the height of the base as one of the stated purposes of the magazine of Bottswein et al. is to protect the test elements from environment conditions such as moisture by storing the test elements in the magazine, wherein the test elements are accessed for use using an ejector slide which then pushes a test element out of the magazine to the outside environment. For this reason alone, the Applicants respectfully request that this rejection be withdrawn.

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Furthermore, the Applicants respectfully submit that there is no motivation to modify the magazine of Bottswein et al. as suggested by the Examiner. The Examiner asserts that the choice of making the container shorter than the test strips is advantageous because less material will be required and the test strips will be accessible and as such it would be obvious to modify the magazine of Bottswein et al. to have a magazine about 2/3 the length of each test element to gain the above-described advantages. However, as further described below, to modify the magazine of Bottswein et al. as suggested by the Examiner is contrary to the teachings of Bottswein et al. relating to protecting the test elements and preventing the exposure thereof to environmental conditions and as such there is no motivation for such modifications for at least this reason. Furthermore, to modify the magazine of Bottswein et al. as suggested by the Examiner one would have to selectively adopt elements of the magazine, but disregard others and there is no motivation or suggestion for such selective adoption.

The Applicants respectfully submit that there is no motivation to modify the magazine of Bottswein et al. as suggested by the Examiner because to do so would leave the test elements unprotected and exposed to the environment which is contradictory to one of the stated purposes of the magazine.¹ In fact, Bottswein et al. specifically teach a magazine for storing test elements wherein the entire length of the test elements are positioned inside the magazine and in fact the magazine is specifically designed for positioning the entire test element inside the magazine. Accordingly, while the subject claims specify that the base of the housing is dimensioned so that a portion of the test strips stored therein extend beyond the height of the base, Bottswein et al. specifically teach that the entire length of each test element is retained in the magazine (see for example Figs. 2, 3 and 4). In this regard, Bottswein et al. teach that the magazine has pairs of opposite side grooves located on the inside surface of the magazine into which the test elements to be stored are inserted (see for example col. 7, lines 56-57). Specifically, the two opposite ends of a test element are positioned inside the magazine such that each end is inserted in to a side groove of the magazine such that the entire length of a given test element is retained within the magazine by insertion of the two ends of the test element into grooves located on the inside of the magazine.² In other words, by virtue of positioning the two opposite ends of a test

1 "Most test elements have to be protected against moisture to avoid reagent decomposition...In addition it is usually necessary to protect test elements from mechanical influences and contamination in order to ensure reliable analytical results." (col. 1, lines 19-27).

"It has already been mentioned that in addition to ordering and dispensing test elements, the magazine can also have the function of protecting the test elements from moisture and mechanical influence." (col. 4, lines 14-17)

2 "If, as intended by the invention, both ends of the test elements are guided in grooves and the test elements are arranged next to one another instead of above one another as in the prior art, then as a rule the test elements, but at least the two ends

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element into respective side grooves located on the inside surface of the magazine as described by Bottswein et al., the entire length of the test element is retained in the interior of the magazine. It is only during removal of a test element from the magazine, accomplished by pushing a test element through an opening in the magazine using a slide ejector, that a test element is exposed to the environment. Modification of the magazine to make it shorter than the test elements stored therein, as suggested by the Examiner, would leave the test element unprotected and exposed to the environment which is contrary to the teachings of Bottswein et al. Accordingly there is no motivation to modify the magazine of Bottswein et al. to make the magazine shorter than the test elements because to do so would leave the test elements unprotected and exposed to the outside environment, which is in contradiction to the teachings of Bottswein et al.

Furthermore, there is no motivation to make the magazine shorter than the test elements to provide access to the test elements stored in the magazine, as suggested by the Examiner to make the test elements more accessible, because the test elements stored inside the magazine are readily accessed and pushed out of the magazine using an ejector slide (see for example Fig. 2). Accordingly, there is no reason why it would be necessary to have some part of the test element extend beyond the magazine to provide for access to the test element as the magazine of Bottswein et al. already includes means to readily access a test element. To modify the magazine as suggested by the Examiner would require one to selectively adopt elements of the magazine, but disregard the ejector slide and method for accessing and pushing a test element out of the magazine. However, there is no motivation or suggestion for such selective adoption.

The Examiner refers to *In re Dailey* and Eilers to support the assertion "that the configuration of a container is a "mere matter of choice" not significantly novel to define over the art". However, the court in *In re Daily*, held that the configuration at issue was a matter of choice which a person skilled in the art would have found obvious absent persuasive evidence that the particular configuration was significant. As clearly described in the specification of the subject application, embodiments of the subject devices, wherein the height of the base is less than the length of a test strip such that a portion of each of the test strips stored in the base extends beyond the height of the base, enables an individual to easily grasp a single test strip stored in the base. Accordingly, such base dimensions are not mere matters of choice, but rather are significant to enable easy access to the stored test strips. However, as noted above, access to the test elements stored in the magazine of Bottswein et al. is by an ejector slide

of the test elements can be definitely positioned." (col. 2, lines 52-57 underline added; see also col. 3, lines 19-23)

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and thus there is no reason to modify the magazine to shorten it so that a portion of the test elements extend beyond the magazine.

For at least the reasons described above, the subject claims are patentable over the cited reference. As such, the Applicants respectfully request that this rejection be withdrawn.

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Conclusion

In view of the above amendments and remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, Order No. LIFE033.

Respectfully submitted,
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Date: 3/11/04

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